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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/031,690 | 05/31/2002 | Frank Bongardt | H 4043 PCT/US | 8266 |

23657 7590 10/08/2004

COGNIS CORPORATION
PATENT DEPARTMENT
300 BROOKSIDE AVENUE
AMBLER, PA 19002

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| EXAMINER |
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TOOMER, CEPHIA D

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| ART UNIT | PAPER NUMBER |
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1714

DATE MAILED: 10/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/031,690

Applicant(s)

BONGARDT ET AL.

Examiner

Cephia D. Toomer

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 14-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Specification

1. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 14-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wenzel US 20030093941.

Wenzel teaches a fuel additive composition comprising a) one or more water-soluble alcohols having between 1 and 5 carbon atoms in an anhydrous state or as a 0.5-36 % aqueous solution one or more of b) one or more straight or branched chain alcohols having between 6-18 carbon atoms and c) one or more ethoxylated alcohols having between 12 and 18 carbon atoms where the ethylene oxide add-on is less than 5 moles and d) a source of nitrogen in an anhydrous state or as an aqueous solution (see abstract paragraph 223-229). The fuel may be any fossil fuel such as diesel (see paragraph 243). The composition may or may not contain water (see col. 28, examples and

paragraphs 0440 & 0666). Wenzel teaches numerous fuel to additive ratios that encompass the claimed proportions, for example 99:1 to 50:50 (see paragraph 229).

In the examples, Wenzel discloses that the alcohols having 6-18 carbon atoms are present in the composition in an amount from 6-32 parts by volume (see paragraph 375, 377, 379, 381, etc) and the ethoxylated alcohol is present in an amount from 2-32 parts by volume (see paragraph 381, 383, 385). The other additives (a source of nitrogen) is present in the composition in an amount from 0.3-6 parts by volume (see paragraph 375, 381, 379). Wenzel teaches the limitations of the claims other than the differences that are discussed below.

In the first aspect, Wenzel differs from the claims in that he does not specially teach a composition wherein the $C_{12} - C_{24}$ branched alcohol is present. However, it would have been obvious to one of ordinary skill in the art to have employed such a compound because Wenzel teaches that one or more straight or branched-chain alcohol having 6 – 18 carbon atoms may be employed, and he exemplifies straight chain alcohols having 18 carbon atoms which clearly suggested that a branched chain of the same length may be included in the composition.

4. Claims 28-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over. Wenzel further in view of Boehmke (US 4,297,107).

Wenzel has been discussed above. Wenzel fails to teach or suggest the claimed corrosion inhibitor. However, Boehmke teaches that 0.5 –6% of ethoxylated carboxylic acid amides are employed in diesel fuel additives as

Art Unit: 1714

emulsifiers and rust inhibitors (see abstract; col. 1, lines 23-31; col. 4 lines 28-35).

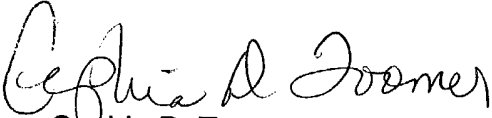
It would have been obvious to one of ordinary skill in the art to have employed the ethoxylated carboxylic acid amides in the fuel additive because Boehmke teaches that these compounds function as emulsifiers and rust inhibitor in fuel additives that contain alcohols and water.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 571-272-1126. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1714

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Cephia D. Toomer
Primary Examiner
Art Unit 1714

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